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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,097	04/10/2000	Henrick K. Gille	08041-007001	2573
20985	7590	09/09/2004	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			JOHNSON III, HENRY M	
			ART UNIT	PAPER NUMBER

3739

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/546,097

Applicant(s)

GILLE ET AL.

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/26/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 28-81 and 83-96 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 3, 4, 7, 33, 37, 38, 45, 49, 50, 64, 65, 68, 75, 76, 79, 87, 88 and 91 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims rejected are 1,2,5,6,8-12,28-32,34-36,39-44,46-48,51-63,66,67,69-74,77,78,80,81,83-86,89,90 and 92-96.

DETAILED ACTION***Response to Arguments***

The Applicant's arguments filed 07/26/2004 have been fully considered. The rejections based on Degler et al. and Herczog et al. are affirmed. The Applicant's remarks state that Degler's "beveled electrode simply forms an incision". Likewise regarding Herczog, the Applicant states "the tissue 14 is incised at 15 by the cutting edge 11". *The American Heritage® Dictionary* definition of incision is: in-ci-sion *noun*

1. The act of incising.
2. *Medicine.* a. A cut into a body tissue or organ, especially one made during surgery.

Based on the definition, there is no distinction between cutting and incising. The beveled edges of both Degler and Herczog form an edge capable of cutting (making an incision). The actual or intended use of a device does not alter its structure.

The indicated allowability of claims 28 and 56-62 is withdrawn in view of the newly discovered reference(s) to U.S. Patent 6,447,511 to Slater and U.S. Patent 5,324,289 to Eggers. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 2, 8, 10, 11, 29, 32, 34, 40, 41, 42, 44, 46, 52, 53, 54, 63, 69, 71 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,228,800 to Degler et al (Degler). Degler discloses an electrosurgical instrument comprising an electrically insulated housing, constructed of a nonconductive material and having a substantially pencil shaped configuration, a blade assembly mounted in said housing and projecting from said housing, said blade assembly comprising a center electrode, insulation means on opposite sides of said electrode and side electrodes (Col. 7, lines 7-12). The center electrode has a beveled cutting edge and is stainless steel and the side electrodes are silver (Col. 7, line 39). The beveled edges form an angular cutting surface around the electrode body (Col. 4, lines 43-44). The tip is essentially shaped like a lance (Figs. 3 and 5) and the electrodes are connected to the energy source (Fig. 2) via contacts (Fig. 3, #39) in the housing. A switch in the handle is provided to energize the electrode. The side electrodes are interpreted as meeting the requirement for at least one electrode attached to a non-mechanical cutting edge of the tip. The electrodes of the applicant's disclosure are cited as "formed on both **sides** of the tip" on page 4, line 6 and line 27, thus supporting the edge cited in the claims as being defined as "the area or part away from the middle" (*The American Heritage® Dictionary of the English Language: Fourth Edition*).

Claims 1, 2, 10, 29, 30-32, 34, 41, 44, 46, 52, 53, 63, 71, 74, 80, 83, 85, 86, 92 and 94-95 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,248,231 to Herczog et al (Herczog). Herczog teaches a surgical cutting instrument with a cutting edge made of an insulating material (Col. 2, lines 35-40) with electrodes attached to the sides (non-mechanical cutting edges) of the instrument and electrically connected to an electrical source (Fig. 1). The electrodes may be made of platinum (Col. 1, line 47). The cutting edge is detachable from the handle (Col. 3, line 35). The blade substrate is made of glass (silicon carbide, Col. 5, lines 12-15). It further has two sides or facets (Fig. 1).

Claims 28, 56 and 60-61 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,447,511 to Slater. Slater teaches surgical scissor blades with a cutting portion

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(Fig. 6, 26b) and an electrode portion (Fig. 6, # 26q), the blades being coupled to push rod to allow movement of the tip from an actuator in the handle (Col. 5, lines 15-25). Movement of the scissor blades by the actuator, moves the electrode portion across the adjacent blade surface. The electrode portion may be formed from gold (Col. 8, line 7). The tip is disclosed as typically constructed of stainless steel (Col. 3, lines 52-55).

Regarding claim 61, the scissor blades have two flat surfaces that are interpreted as facets, thus yielding a bi-facet edge.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 43, 55, 73, 84 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,248,231 to Herczog et al (Herczog) in view of U.S. Patent 5,925,043 to Kumar. Herczog is discussed above, but does not teach a titanium nitride coating. Kumar discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar in the electrode of Herczog as an obvious design choice.

Claims 5, 6, 9, 35, 36, 39, 47, 48, 51, 66, 67, 70, 77, 78, 81, 89, 90 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,248,231 to Herczog in view of U.S. Patent 4,640,279 to Beard. Herczog is discussed above but does not teach the use of a non-stick coating. Beard discloses a surgical scalpel with an electrode attached to a non-cutting

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edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Herczog to keep tissue from sticking to the device and reduce friction of the device in the tissue.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,248,231 to Herczog in view of U.S. Patent 4,228,800 to Degler. Herczog is discussed above but does not teach the use of a button on the handle to activate the electrodes. Degler is discussed above and further teaches a button on the probe (Fig. 1, # 45) for selecting the electrode waveform (Col. 3, lines 44-48).

Claims 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,447,511 to Slater as applied to claim 28 above, and further in view of U.S. Patent 4,640,279 to Beard. Slater is discussed above but does not teach a non-stick coating. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Slater to keep tissue from sticking to the device and reduce friction of the device in the tissue.

Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,447,511 to Slater as applied to claim 28 above, and further in view of U.S. Patent 5,925,043 to Kumar. Kumar discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar in the electrode of Slater as an obvious design choice.

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Allowable Subject Matter

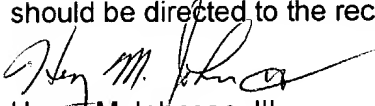
Claims 3, 4, 7, 33, 37, 38, 45, 49, 50, 64, 65, 68, 75, 76, 79, 87, 88, and 91 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Henry M Johnson, III
Patent Examiner
Art Unit 3739


Lee Cohen
Primary Examiner